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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,629	06/19/2000	Connie L. Chapman	FE0040355504	4379
27975	7590	03/01/2005		
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A. 1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE P.O. BOX 3791 ORLANDO, FL 32802-3791			EXAMINER BLAIR, DOUGLAS B	
			ART UNIT 2142	PAPER NUMBER

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/596,629

**Applicant(s)**

CHAPMAN ET AL.

**Examiner**

Douglas B Blair

**Art Unit**

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68 and 70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68 and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Claims 1-70 are currently pending in the application.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31-39, 41-49, 51-58, and 60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are all directed towards software. Computer programs must be tangibly embodied on some form of computing device.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,377,355 to Hager et al. in view of U.S. Patent Number 5,781,901 to Kuzma.
5. Hager teaches the invention substantially as claimed (As in claim 52) including an intranet for distributing an invention disclosure, the intranet having a plurality of users enrolled therein, each of the plurality of users having associated personnel information stored within the

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intranet (col. 5, lines 1-15), the intranet comprising: a first software module for creating and submitting an invention disclosure over the intranet, the invention disclosure being submitted by an inventor (col. 4, lines 40-61); a second software module for creating a profile of the invention disclosure based upon a technical area relating to the invention disclosure in response to accessing associated personnel information of the inventor (col. 4, lines 62-67 and col. 5, lines 1-15); a third software module for transmitting first notification message via e-mail to a first group of users based upon the created profile, the first group of users being within the plurality of users (col. 4, lines 62-67 and col. 5, lines 1-15); a fourth software module for transmitting a second notification message via e-mail to a second group of users based upon the created profile, the second group of users being within the plurality of users and including a technical review coordinator (col. 6, lines 17-34); a fifth software module for selecting at least one evaluator by the technical review coordinator (col. 9, lines 66-68 and col. 10, lines 1-9); a sixth software module for transmitting a third notification message via e-mail to the at least one evaluator (col. 6, lines 17-34); a seventh software module for submitting evaluation comments by the at least one evaluator (col. 7, lines 5-42); an eighth software module for submitting a recommendation of the invention disclosure by the technical review coordinator based upon the evaluation comments (col. 9, lines 37-57); and a ninth software module for transmitting the recommendation of the invention disclosure via e-mail to the first and second group of users (col. 10, lines 29-58); however Hagar does not teach including an attachment to the invention disclosure created separately from the invention disclosure nor e-mailing a hyperlink to the document.

Official notice is taken that it was well known in the art at the time of the invention to send a hyperlink to a document instead of an entire document.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hager regarding a system for distributing an invention disclosure with the idea of sending a hyperlink instead of an entire document because sending only a hyperlink reduces the size of e-mails that would be sent, thus reducing network traffic.

Kuzma teaches a software module comprising instruction for including an attachment to a document the attachment having been created separate from the document (col. 4, line 65-col. 5, line 24).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hager regarding a system for distributing an invention disclosure with the teachings of Kuzma regarding creating an attachment separately from a document because creating an attachment separately from a document saves network resources (Kuzma, col. 1, lines 35-50).

6. As to claims 53, Hager teaches an intranet wherein the third software module for transmitting the first notification message is responsive to submission of the invention disclosure (col. 4, lines 62-67 and col. 5, lines 1-15).

7. As to claim 54, Hager teaches an intranet wherein the fourth software module for transmitting the second notification message is responsive to submission of the invention disclosure (col. 6, lines 17-34).

8. As to claim 55, Hager teaches an intranet wherein the profile comprises a functional manager of the inventor, a patent attorney, and technical review person (col. 5, lines 33-41).

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9. As to claim 56, Hager teaches a profile comprising information relating to the inventor including the inventor's employee number, department number, building number, phone number and e-mail address (col. 4, lines 62-67 and col. 5, lines 1-15).

10. As to claim 57, Hager teaches an intranet wherein the first group of user comprises a business area manager, a supervisor of the inventor, and the inventor (col. 4, lines 62-67 and col. 5, lines 1-15).

11. As to claim 58, Hager teaches an intranet wherein the second group of users comprises a technical review coordinator, a contract administrator if the invention was developed under government funds, and an intellectual property administrator (col. 7, lines 32-42).

12. As to claim 59, Hager teaches a software module for creating an invention disclosure further comprising instructions for including an attachment (col. 4, lines 40-61).

13. As to claim 60, Hager teaches a software module for creating an invention disclosure comprising instructions for sending a notification message to a co-inventor (col. 4, lines 40-61).

For reasons discussed above it would have been obvious to include a hyperlink in this message.

14. As to claims 1-11, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

15. As to claims 12-21, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

16. As to claims 22-30, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

17. As to claims 31-41, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

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18. As to claims 42-51, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

19. As to claims 61-70, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

### ***Response to Arguments***

Applicant's arguments filed 9/14/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The arguments state that the attachment is part of the invention disclosure but provides no mention of this relationship in the claims.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 571-272-3896. The fax phone numbers for the

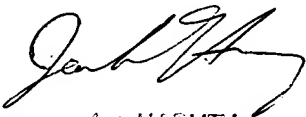
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organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair

DBB

  
JAMES H. BLUM  
REGISTERED PATENT ATTORNEY